

REMARKS

Reconsideration and allowance of this application are respectfully requested in light of the following remarks.

Applicants would like to thank Examiner Retta for the Office Interview and hereinafter summarize the agreements reached and arguments Applicants made during the Office Interview that took place June 23, 2004 regarding overcoming the objections and rejections of the Office Action mailed March 15, 2004.

SUMMARY OF THE OFFICE INTERVIEW

I. Applicants Argued That Their Invention Is Not A “Workflow” System and Process

Applicants argued and Examiner agreed that Applicants’ invention is not a workflow and the business rules are not workflow business rules, as taught by the Lynn reference. However, Examiner explained that the claimed features, “means for specifying business rules” and “means for specifying roles” was broadly interpreted by the Office in the Office Action.

The Office Action alleges that the invention of claim 1 recites a workflow system. During the Office Interview Applicants argued that their present invention does not disclose or claim a workflow, as workflow is understood by those ordinarily skilled in the art to be a flow of work between individuals and/or departments that is defined and tracked. Applicants’ further argued that their invention does not disclose or otherwise imply controlling the structure, operation and strategy of the publication business. Applicants’ argued that their invention is directed to a system and method for a Company advertiser and a Publisher to jointly administer and create ads. Applicants emphasized that the claimed invention of claim 1 does not recite control of any aspect of the publication business but is directed to creating ads that conform to Company advertiser needs and Publisher requirements. In the Office Interview Applicants stated that the claimed invention provides a person who needs to advertise a system and method to directly create an ad that conforms to preset rules concerning format, size, submission deadlines and even approvals by providing templates whose entries are governed by predetermined rules and whose entries are accessible only by preauthorized roles. These rules and roles are jointly defined by a Company advertiser and a Publisher using an ad template. Further, the Publisher

can be other than the publication business, e.g., a web site that wants to control look-and-feel of ads, while providing maximum flexibility to ad creators to exercise their creative talents. The Publisher can be any provider of advertising content in any media (a movie theatre, a radio station). Contrary to the allegation of the Office Action, Applicants asserted, the invention of claims 1 and 20 provides a Company advertiser and a Publisher with the ability to control ad format and content and is not intended to provide control of publishing industry structure, operation and strategy.

While there is arguably some overlap between traditional workflow and Applicants' invention, Applicants argued that this overlap results from the natural flow of work wherein one step follows another, and that the invention disclosed and claimed in the present Application is not a "workflow" as known in the art since neither the disclosure nor the claims recite traditional "workflow" functions of defining and tracking a flow of work between individuals and/or departments. While the present invention allows deadlines for ad creation to be defined there is no way to define a set of steps that must be performed in given order, i.e., workflow, by a given time.

Applicants further argued that the purpose of the business rules as defined by their invention is to eliminate workflow and therefore the Lynn reference is not relevant prior art and the Examiner agreed.

Applicants agreed to amend independent claims 1 and 20 to recite using an ad template to specify each of 'business rules' and 'roles'.

II. Applicants Argued That "Business Rule" Is Defined In The Specification

Throughout the specification and claims of the present Application, Applicants define the term "business rule". A term used in the claims may be given a special meaning in the description (MPEP 608.01(o)). Applicants respectfully refer the examiner to at least the following paragraphs in the present Application as reciting their definition, i.e., special meaning, of "business rule":

[0015] ... means for Publishers to specify publication style rules and for Companies to capture their requirements as business rules ... in a ... database 500

[0017] ... administrative deadline rules are incorporated into Ad Box and Ad Master templates stored in a ... database 500 ... and are completely customizable ...

[0026] ... The formats, deadlines, and processes can be varied by varying the corresponding business rules captured in the ... database 500

[0105] ... the Administrator [role] sets up Ad Master templates that incorporate both Company and Publisher business rules.

[0108] ... Ad Box and Ad Master templates embodying Company and Publisher business rules ...

[0112] This flexibility of retention and archiving is implemented by business rules stored in the Company and Publisher database 500, ...

[0115] ... each Publisher can establish and maintain its own style by enforcing style and format business rules at the time of Ad Box creation and Ad Master layout by Company personnel.

[0122] ... entry for ... lines are defined by the business rules associated with the default template in the database ...

[0123] ... digitized images ... sizes that are defined by a business rule in terms of pixels in the database ...

[0137] ... status an Ad Master can assume is an example of the administrative business rules ...

[0141] ... to be purged a set number of days after publication, with the number of days determined by a business rule associate with the corresponding Ad Master Template ...

[0148] ... Each Publisher has the option of specifying a preferred format [as a business rule concerning image format types]

[0152] ... each Publisher has the option of specifying business rules governing deadlines for submissions by personnel fulfilling the defined roles, e.g., Company Agents ...

[0156] ... A business rule determines the format for this exchange [of an ad between Company and a Publisher] ...

[0158] .. E-mail messages are automatically sent between ... roles when a business rule determines that such an e-mail message is to be sent ...

Thus, in the present invention business rules are defined as related to Ad Box and Ad Master templates such that business rules operationalize Company advertiser and Publisher constraints (the rules) on the joint creation and administration of ads by their respective personnel (the roles-see below) who use these templates to format ads and when they do so have their actions/choices constrained by these business rules. Applicants argued that there is no flow of work controlled by any business rule.

III. Applicant Argued That “Role” Is Defined in The Specification

Applicants have formally defined what is meant by a “role” beginning at paragraph [0160] and continuing through paragraph [0237]. As defined in these paragraphs, there can be any number of Company advertiser roles and Publisher roles having corresponding database 500 access privileges, where privileges include the actions a role can take with respect to data in the database 500 (paragraph [0161]). Business rules and possibly ads (claims 11-12) are claimed as part of the database 500 for which all roles (also claimed as part of database 500) have pre-defined access privileges (paragraph [0162]). An example of a privilege solely assigned to a role of Publisher Super Administrator is the privilege to change Publisher-specific business rules and is described in paragraph [0160]. An example of a role for specifying business rules for both the Company rules and particular publication style is given in paragraph [0163].

That is, a role is defined as comprising database access privileges since all data defining business rules, roles, ad templates and ad instances can be contained in a database. One of the access privileges is to define and modify business rules and even the roles, since roles and rules are flexible and can be revised and reassigned at any time. Further, the claimed roles are intended to operationalize an agreed upon administrative process (Applicants' note that this process is not a Workflow) between a Company and Publisher (paragraph [0162]).

IV. Applicants Argued That Kashino Does Not Teach Creating Ads or Defining “Roles”

Applicants argued that Kashino teaches making correction annotations relative to an already created image by providing the already created image in a separate layer along with a plurality of overlaying annotation layers, such that access to the annotation layers is controlled

by a password associated with each named layer. Applicants pointed out that while each layer has a label, the label has no meaning, i.e., while a label for a layer might be equivalent to a role of the present invention there is no meaning either structurally or functionally defined by Kashino for a label of a layer. Every label has an associated password that allows the holder thereof to enter annotations in that layer. That is, the label is just a label that distinguishes among the layers for purposes of separating annotations but not for constraining (by rules) what annotations can be made in that layer. There are no business rules taught by Kashino.

Furthermore, Applicants argued that there are no “roles” taught by Kashino but only labels for annotation layers which can be anything including the name of a “role” of the present invention.

In addition, Applicants argued that Kashino does not teach creation of the image itself and does not teach changing the image itself by anyone with password access to a labeled layer.

Finally, Applicants argued there are no templates taught by Kashino.

V. Applicants Argued That Their Invention Is a Template Driven Ad Specification System For Empowering End Users In the Creation and Administration of Ads

Applicants argued that their system differs from other ad preparation systems in that it allows any degree of user control over the creation and administration of ads. The present invention provides this user control using Ad Box and Ad Master Templates comprising elements having associated rules and roles, rules for controlling what can be done to the element and roles for authorizing who can do what. These rules and roles are made accessible to and definable and modifiable by Company advertiser and Publisher alike. The Templates, rules and roles and the ads created thereby are stored in a database for long term access and reuse by Company advertiser and Publisher personnel.

VI. During the Office Interview Applicants Provided a Demonstration CD Of A “VIRTUAL ADTAKER” Embodiment of The System and Method Of The Presently Claimed Invention As Well As a Comparative Analysis of Products Competitive With This Embodiment; Applicant Also Gave An On-line Demo of this Embodiment.

RESPONSE TO REJECTIONS

VII. Claims 1-4, 20, 25 and 26 Are Rejected Under 35 U.S.C. §103(a) As Being Unpatentable Over Kashino (U.S. Patent No. 6,166,716) In View Of Lynn et al. (U.S. Patent No. 6,606,740, hereinafter “Lynn”)

The Office Action Position

The Office Action alleges that Kashino teaches company advertiser and ad publisher personnel roles to accomplish preparation of ads for publication wherein the ads are formatted for at least one ad delivery medium (col. 8 line 48 to col. 9 line 28). The Office Action further alleges that Kashino teaches preparation and administration of ads for publication by said roles according to business rules (see FIG. 7 and related columns). The Office Action admits that Kashino does not explicitly teach means for specifying the business rules to control preparation and administration of ads for publication and storing the rules and personnel roles in a database. The Office Action further alleges that Lynn teaches specifying customized business rules as required to fit enterprise environment (citing Abstract) and database for storing business rules and roles performed according to the business rules (citing col. 2 lines 5-55, col. 3 line 10 to col. 5 line 65, col. 6 line 19-58, and col. 22 line 33 to col. 23 line 53). The Office Action additionally alleges that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Kashino's publishing of ads and Lynn's software for creating business rules for the purpose of describing and controlling the structure, operation and strategy of the publication business.

Applicants Response

In view of the amendment of independent claims 1 and 20, the rejection is mooted, since neither Kashino nor Lynn teach an ad template for specifying business rules and roles, and the rejection should be withdrawn.

In addition, Applicants respectfully traverse.

At the outset and as argued during the Office Interview, Applicants' assert that their invention (independent claims 1 and 20) does not disclose or otherwise imply controlling the structure, operation and strategy of the publication business and is not directed to “workflow”. Applicants' invention is directed to a system and method for a Company advertiser and a

Publisher to jointly administer and create ads thereby streamlining the process of creating ads. The point being that Applicants' claimed invention does not recite control of any aspect of the publication business but is directed to creating ads that conform to Company advertiser needs and publisher requirements. It gives a person who needs to advertise the ability to directly create an ad that conforms to preset Company advertiser and Publisher rules concerning format, size, submission deadlines and even approvals by providing templates whose entries are governed by predetermined rules and whose entries are accessible only by preauthorized roles. The publisher can be other than a publication business, e.g., a web site that wants to control look-and-feel of ads, while providing maximum flexibility to ad creators to exercise their creative talents. The publisher can be any provider of advertising content in any media (a movie theatre, a radio station). Contrary to the allegation of the Office Action, the present invention provides a company and a publisher with the ability to control the ad content and is not intended to provide control of industry structure, operation and strategy.

With regard to roles, at the reference cited by the Office Action (col. 8 line 48 to col. 9 line 28), (1) Kashino does not teach specifying Company advertiser and ad Publisher personnel roles to accomplish preparation and administration of ads for publication; and (2) Kashino does not teach any Company advertiser roles, both as recited by present independent Claims 1 and 20. Kashino uses a publication example, illustrated in FIGs. 7-15, to explain Kashino's invention of a multi-layer presentation apparatus for two-dimensional picture information wherein annotators each can make their annotations (see FIGs. 8A-8D) in a separate layer (see FIG. 9, L0-L3). Kashino teaches these separate layers have layer names (col. 10, line 26) or title windows 103 (col. 10, line 20). Kashino teaches that the layer name can be an annotator name in the ad example cited by the Office Action in FIG. 7 and related columns. Kashino teaches that a named layer is separate from the ad image (or other image being annotated) and is used only for providing commentary by those having a pre-determined password for access to the named layer. While it is possible to name a layer with what appears to be a "role", the name is just a distinguishing label for the layer. A user does not have to identify him or her-self by the layer name, but only has to select the named layer from a displayed list (FIG. 10) and supply a pre-determined password (FIG. 11) to gain access to the layer for purposes of making annotations to

an image contained in another and inaccessible layer, e.g., L0 in FIG. 9. An example of the same named layers with user names instead and further including a common annotation layer, is shown in FIG. 14, the layer names are themselves just data, and are arbitrary.

Further, the access taught by Kashino is to a layer and not to a database. The Office Action admits there is no database taught by Kashino. Thus, in the proposed combination with Lynn not only would Kashino have to be modified to establish a database that includes the named layers but a person having a password to access the layer in the database would have to have access the database to change the layer in the database. The “roles” of the present claimed invention, as described above, include access rights to a database. In Kashino, the only access right possessed by a password holder is to provide his/her annotation but not to change the underlying image (Ad). Thus, the proposed combination of Kashino and Lynn is made by the Office Action without any motivation in the references themselves or knowledge in the prior art, both of which are necessary to establish a prima facie case of obviousness under existing authority, see *Ex Parte Levengood*, 28 USPQ2d 1300, 1993.

With regard to “business rules” recited by the claimed invention, as discussed above, Applicants’ specification defines “business rules” as rules governing the joint creation and administration of ads by a Company advertiser and Publisher for publication by a Publisher. The Office Action alleges at page 2, middle of last paragraph, that the Kashino reference teaches preparation and administration of ads for publication by said roles *according to business rules* (FIG. 7 and related columns). Applicants respectfully assert that (1) only col. 8 line 49 to col. 9 line 28 relate to FIG. 7, and (2) that there are no business rules let alone means for specifying business rules taught either in FIG. 7 or in the columns related to FIG. 7. Nowhere in the cited reference does Kashino teach business rules according to the definition provided by the Applicants in the present Application.

Contrary to the allegation of the Office Action, Applicants assert that nowhere does Kashino teach preparation and administration of ads by company advertiser and publisher personnel roles according to specified business rules, as recited by independent Claims 1 and 20, and Claims 2-19 and 21-26, respectively dependent therefrom. Kashino only teaches that the labels of annotation layers can be anything, including a personnel role name. There is no

function associated with a label and the only function for any and all layers is annotation of an image contained in a separate layer. All layers have the same function regardless of their individual labels. Access to the layers is controlled by individual passwords for each layer. A list of layer names is presented and the user selects a layer name (layer label) and supplies a password to gain access to the named layer. Then the user is able to enter annotations in that layer. This is not a teaching of a role or a rule for creating an image let alone an ad. Kashino only teaches capturing annotations in separate labeled layers, access to which is password controlled. The present claimed invention recites no such limitation of password controlled layers having labels equivalent to roles.

The Office Action admits that Kashino does not explicitly teach means for specifying the “business rules” to control preparation and administration of ads for publication and storing the rules and roles in a database. The Office Action alleges that this is taught Lynn. Applicants respectfully disagree. Lynn teaches that business processes (not business rules as alleged by the Office Action) can be customized as required to fit the enterprise environment (Abstract). Further, Lynn teaches providing business specific workflow rules by various workflow applications (col. 2 lines 5-55) and using a scalable workflow processing framework to develop a workflow processing system that includes a set of software objects to support corresponding business functions, a database defining work taxonomy and work steps for workflow processing to be performed by a workflow engine. (Col. 3, line 10-24). Essentially, Lynn is teaching an enterprise workflow for any line of business that can be mapped to a case paradigm such as child welfare case processing, telephone bill presentment processing, health claims processing, dispute processing, fraud recovery processing, new application processing, return mail processing, and many more, for an enterprise environment (col. 4, lines 52 through col. 5 lines 7). At col. 6, lines 40 - 44 Lynn teaches a Case Builder to determine either when to create a new case or when and how to rendezvous an incoming document with an existing case folder. Folders contain material such as electronic documents, images, data records, etc. used by each case and workflow function (col. 5, lines 42-45).

Lynn does not teach ‘business rules’ and “roles” as disclosed and claimed by Applicants in the present Application. Lynn does not anywhere teach software to create business rules as

alleged by the Office Action but teaches “workflow business rules” and Applicants have argued and assert again that their invention does not claim a workflow or workflow business rules. Lynn teaches a workflow processing framework and Applicants are not disclosing or claiming a workflow processing framework or any kind of enterprise control application for describing and controlling the structure, operation and strategy of the publication business. Nor would combining Kashino’s example of annotating an ad image using Kashino’s presentation apparatus with Lynn’s enterprise workflow processing framework result in describing and controlling the structure, operation and strategy of the publication business because Kashino does not describe the publication business. Thus, there would be no motivation to combine Kashino with Lynn because (1) Lynn does not teach software to create business rules and roles and (2) Kashino does not teach publishing of Ads, Kashino teaches annotation (not editing) of a 2-dimensional image which may be an Ad.

With regard to the Office Actions' allegation that it would have been obvious to one of ordinary skill to combine Kashino's publishing of ads and Lynn’s software for creating business rules because one would have been motivated to implement Lynn's software to create business rules for Kashino's publishing of ads for the purpose of describing and controlling the structure, operation and strategy of the publication business, Applicants respectfully assert that since Kashino does nowhere teach the use of business rules for any purpose, let alone controlling the structure, operation and strategy of the publication business, it would not have been obvious how to modify Kashino to use any business rule software, especially since Kashino is directed to a presentation apparatus for annotation by at least one annotator of two-dimensional picture information and not to the structure, operation and strategy of the publication business.

In view of all of the foregoing discussions, the Office Action has not made out a prima facie case of obviousness, independent Claims 1 and 20 are allowable, and Claims 2-19 and 21-26, respectively dependent therefrom, are allowable for at least this reason.

VIII. Claims 5-19 and 21-24 Are Rejected Under 35 U.S.C. §103(a) As Being Unpatentable Over Kashino, In View Of Lynn et al. (U.S. Patent No. 6,606,740, hereinafter "Lynn ") And Further In View Of Johnson et al (U.S. Patent No. 6,453,301, hereinafter "Johnson").

The Office Action Position

The Office Action admits that Kashino, as modified by Lynn, does not teach Ad Box default template defining a plurality of entries for each Ad Box instance or Ad Master template defining a plurality of components for each Ad Master instance; the Ad Box Default Template and Ad Master Template being defined by at least one of company advertiser or ad publisher being controlled by at least one of the plurality of business rules; storing the template (see col. 5 lines 33-67, col. 7 line 29 to col. 8 line 11) ... associated business rules; the business rule determining deadlines and attribute of entries for each Ad Box and Ad Master instances; creation editing and storing of the ad templates and associated business rules ,sending to publisher, setting and status ... (see col. 8 line 57 to col. 9 line 59). The Office Action alleges that Johnson teaches a presentation generation system that integrates customer specific information with a selling entity element to generate a presentation item for sale of product customized for a particular customer of the selling entity (Abstract). The Office Action further alleges that Johnson teaches templates used to develop a presentation item (ad) and templates used by the customer solution system to receive customer information and to generate a customer solution, templates such as programs, rules or instructions which perform the functions of ... (see col. 8 lines 43-56). Also, the Office Action alleges that Johnson teaches the template being used to generate customized presentation items, including presentation format templates, indicating the various information to be integrated to form a presentation item (ad). The presentation format template associated with rules defining, for example, the layout of a presentation item which implies that templates [are] being controlled by associated business rules and [are] being defined by at least one of company advertiser and ad publisher. The Office Action further alleges that it would have been obvious to one of ordinary skill in the art to modify Kashino's publication of ads by including Johnson's templates associated with and controlled by business rules in order to quickly and easily create the presentation (ad).

Applicants Response

In view of the amendment of independent claims 1 and 20, the rejection is mooted, since none of Kashino, Lynn, or Johnson teach an ad template for specifying business rules and roles, and the rejection should be withdrawn.

Applicants respectfully point out that there are two citations in the Office Action for this rejection which are not identified as to which reference they are for: (see col. 5 lines 33-67, col. 7 line 29 to col. 8 line 11) and (see col. 8 line 57 to col. 9 line 59). They do not appear to refer to any of the references cited and therefore Applicants are unable to respond to them.

Applicants do note the Office Action concedes that neither Kashino nor Lynn teaches an ad template for specifying business rules and roles for which purpose Johnson has been cited.

In addition, Applicants respectfully traverse.

The customer solution system 102 taught by Johnson generates a customized presentation, not an ad, of available products of a selling entity to be presented to a customer that is based on the customer's requirements for those products (customer specific information) (Abstract; col. 3, lines 23-51). The presentation system taught by Johnson supports a seller organization by generating custom presentations based on customer requirements for products sold by the sales organization. Johnson calls these presentations "proposals" because they are presented to the customers who requested them and are not published as ads (see, e.g., col. 2, line 2; FIG. 18A-0; FIG. 19A-P; FIG. 20A-N; col. 3, lines 29, 60, & 65; col. 4, lines 41; col. 6, lines 42 & 54).

There is no teaching in Johnson of correcting any presentation and Kashino does not teach creating ads but only uses an advertiser placing an ad as an example to explain Kashino's multi-layer annotation apparatus for 2-dimensional images. Kashino is not concerned with creating the image (ad) only with annotating an image using password controlled layers to hold annotations that can be overlaid on a 2-dimensional image. Further, Kashino does not anywhere indicate that the time to create the 2-dimensional image is too long. Because Kashino is not teaching creating the image nor is Kashino identifying the time to create the image as too long, there is no motivation for the replacement of an alleged teaching of ad creation by Kashino with

the system of Johnson. Furthermore, as Johnson does not provide any mechanism for correcting a "proposal", i.e., an image, after it has been generated, there would have been no motivation to combine these two references (even as modified further by Lynn) by one skilled in the art. Both references would have to be modified in order to combine them.

Therefore, the Office Action has failed to make out a *prima facie* case of obviousness, the rejection should be withdrawn and claims 5-19 and 21-24 are allowable.

Conclusion

For at least the above reasons, it is respectfully submitted that the present invention is in condition for allowance and a Notice of Allowance is respectfully requested.

Respectfully submitted,



Noreen O. Welch

Registration No. 45,208

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NOW/att

Attorney Docket No. TPP31705

STEVENS, DAVIS, MILLER AND MOSHER, L.L.P.
1615 L Street, N.W.
Washington, D.C. 20036

Telephone: (202) 785-0100
Facsimile: (202) 408-5200